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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952.

No. 157

BURGESS BATTERY COMPANY,
Petitioner,

vs.

JOHN A. MARZALL
(ROBERT C. WATSON, substituted)
COMMISSIONER OF PATENTS,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

GEORGE I. HAIGHT
HOWARD H. DARBO
CLARENCE M. FISHER
Counsel for Petitioner.

JONES, TESCH & DARBO
20 N. Wacker Drive
Chicago 6, Ill.
Of Counsel for Petitioner

The Scheffer Press, Inc.—ANdover 3-6850

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

To the Honorable, The Chief Justice and the Associate Justices Of the Supreme Court of the United States:

Burgess Battery Company respectfully prays for the writ of certiorari to review the final judgment of the United States Court of Appeals for the District of Columbia Circuit which affirmed a judgment of the United States District Court for the District of Columbia dismissing petitioner's complaint in the above-entitled suit. The *per curiam* decision of the Court of Appeals was by two judges, a majority of the Court, one judge dissenting without opinion.

The District Court opinion is found at R. 6 (see Appendix C hereof); the *per curiam* decision at R. 148 (see Appendix D hereof).

STATEMENT OF THE MATTER INVOLVED.

The complaint was filed by petitioner in the District Court for the District of Columbia against the Commissioner of Patents for a judgment that petitioner is entitled to the registration of its trade-mark (see Appendix A hereof) which registration the Commissioner has refused.

The trade-mark sought to be registered (R. 37 and Appendix A hereof) consists of a panel of vertical alternating black and white stripes. Its use is shown as a part of the side panels of dry batteries made and sold by petitioner. (R. 31 *et seq.*) It is among petitioner's most important trade-marks and is of great value to petitioner.

The application is to register the trade-mark on the principal register of the Trade-Mark Act of July 5, 1946 and particularly Section 2(f) of that Act.

For the pertinent statutory provisions, see Appendix B hereof.

Registration is refused on three grounds sustained by the court:

(1) That a prior holding by the Court of Customs and Patent Appeals that petitioner was not entitled to register the design as a trade-mark under the Trade-Mark Act of 1905 is *res judicata* against the petitioner's application under the new Act of 1946.

(2) That the 1946 Trade-Mark Act did not give a new definition of a registrable trade-mark and a new basis of registrability as compared with the 1905 Act; and

(3) That the design is merely the dress of the goods and is inherently incapable of acquiring the status of a trade-mark registrable on the principal register under the 1946 Act.

The judgment here sought to be reviewed contains the following finding of fact (R. 12):

> "4. The evidence establishes that the plaintiff has used black and white stripes around the sides of almost, but not quite, all of its batteries for more than thirty years, that such use has been continuous and substantially exclusive, and that the name 'Burgess' is also prominently displayed upon the batteries. It further establishes that at least a substantial portion of the trade, including many competitors, jobbers and dealers, and a substantial segment of the purchasing public, have come to associate said stripes design on batteries with plaintiff Burgess Battery Company so that they ordinarily assume, without necessarily looking at the name, that a battery displaying said stripes design is made by plaintiff."

The slogan "Recognized by Their Stripes—Remembered by Their Service" has been registered by petitioner with the United States Trade-Mark Association since 1929. The panel of vertical black and white stripes has been registered in Canada since 1939 under a law there similar to the U. S. 1946 Act.

Section 2(f) of the Trade-Mark Act of 1946 (U.S.C. Title 15, Chap. 22) is as follows:

> "Sec. 2(f) Except as expressly excluded in paragraphs (a), (b), (c) and (d) of this section [not here pertinent], nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. • • •"

The Commissioner has expressed a willingness to register the design on the supplemental register of the 1946 Act but not on the principal register as sought by petitioner. Section 2(f) applies to the principal register.

There was no counterpart to Section 2(f) of the 1946 Act in the Act of 1905 except the ten-year clause which

was available only for marks in use since 1895. Petitioner had not used its stripes design mark that long (although having used it for more than thirty years), and was therefore not able to qualify under the ten-year proviso, but can and does qualify under Section 2(f) of the 1946 Act.

BASIS OF THIS COURT'S JURISDICTION TO REVIEW THE JUDGMENT.

This petition is filed under 28 U.S.C. 1254(1) and Supreme Court Rule 38 (and particularly Sections 5(b) and (c) thereof).

The judgment of which review is here sought was rendered March 5, 1953 (R. 148). A petition for rehearing filed March 30, 1953, was denied April 3, 1953 (R. 160).

The question of trade-mark law here involved is one of general importance to the business community of the country and in the administration of the trade-mark statutes in the Patent Office. The case involves important questions of federal law and of the construction of a statute of the United States, incorrectly decided by the Court of Appeals for the District of Columbia Circuit, and which have not been but should be settled by this Court. *Pecheur Lozenge Co.* v. *National Candy Co.*, 315 U.S. 666; *Steele* v. *Bulova Watch Co.*, 344 U.S. 280, 97 L. ed. (Advance p. 192).

THE QUESTIONS PRESENTED.

The questions presented by this petition are:

A. Whether a decision denying registration of a mark as a trade-mark under the 1905 Trade-Mark Act is *res judicata* in a new application to register the mark under a provision for registration in the 1946 Trade-Mark Act which had no counterpart in the 1905 Act.

B. Whether the 1946 Trade-Mark Act gave a new definition of a registrable trade-mark and provided a new basis for registration as compared with the 1905 Act, and whether the Court of Appeals in affirming the District Court, on the opinion of that Court, affirmed (or acquiesced in) an improper interpretation of a new provision in the Act of 1946 for the registration of a mark which has become distinctive of one's goods in commerce, namely Sec. 2 (f).

C. Whether a court may properly hold as a matter of law that a design device, as petitioner's stripes design, is inherently incapable of acquiring the status of a trade-mark under the Act of 1946 in the face of a finding of fact by the same court that the design device has become distinctive of the applicant's goods in commerce and functions in fact to indicate origin of the goods with applicant.

D. Whether a design device which may incidentally have ornamental or decorative significance but which the trade has come to associate with a particular manufacturer so that it ordinarily assumes that the goods displaying such design device originate with that particular manufacturer, may be refused registration under Sec 2(f) of the 1946 Trade-Mark Act.

REASONS RELIED UPON FOR THE ALLOWANCE OF THE WRIT.

(A)

Taking advantage of new registration provisions of the 1946 Trade-Mark Act, petitioner requested registration under Section 2(f) and made a factual showing that its trade-mark has become distinctive of its goods in commerce, a showing which was neither called for nor permitted under the prior Act. This showing was not before the Patent Office during the proceedings therein

but was introduced during the trial *de novo* in the District Court which petitioner brought under Section 4915 of the Revised Statutes (now 35 U.S.C. Section 145 and Section 21 of the 1946 Trade-Mark Act).

The Act of 1905 having been repealed by the Act of 1946 and the law applicable to the registration of appellant's mark having been changed, and controlling new evidence having been here submitted, the issue joined by the pleadings herein, arising for the first time, is not *res judicata,* and the holding of the Court in that respect is in error.

(B)

Except for the mere statement that appellant filed its application to register its design mark under Section 2(f), the Court gave little consideration to this new basis for registration specifically invoked by petitioner. The Court by its improper interpretation has in effect nullified this provision of the law—the very ground upon which applicant relied for registration of its mark.

(C)

The very essence of the 1946 Trade-Mark Act is that trade-mark status is a question of fact. The Court's conclusion of law that plaintiff's stripes design is inherently incapable of acquiring the status of a trade-mark under the 1946 Trade-Mark Act is contradictory to the Court's own finding of fact that the stripes design has in fact acquired the status of a trade-mark, *i.e.* has become distinctive of petitioner's goods in commerce and is looked upon by the purchasing public as an indication of origin of the goods with petitioner. The Court has erroneously treated the question as one of law.

(D)

Both on reason and authority, a design trade-mark may contribute to the attractive dress of the goods. In *Barbasol Co.* v. *Jacobs,* 160 F. 2d 336 (C.A. 7, 1947) the court held valid a trade-mark which was an ornamental part of a package for shaving cream.

The Patent Office itself has registered under the 1946 Act a Scotch plaid design as a trade-mark for adhesive tape (R. 154) and has indicated a series of candy stripes of indefinite size and extent to be registrable under the same Act as a trade-mark for cotton goods (R. 152). Petitioner should not be discriminated against as a matter of law.

CONCLUSION.

By reason of the present decision, great confusion exists in the business community and in the Patent Office as to the registrability as trade-marks of designs which, while to some extent serving as decoration and dress of the goods, have at the same time become established as distinctive of the goods and an indication of origin thereof.

Wherefore, your petitioner respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia Circuit to review and correct the errors above referred to.

Respectfully submitted,

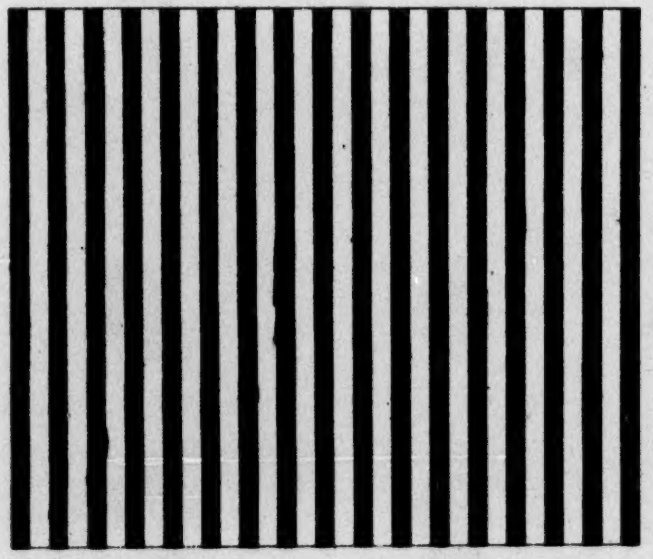
GEORGE I. HAIGHT,

HOWARD H. DARBO,

CLARENCE M. FISHER,
Counsel for the Petitioner,
Burgess Battery Company.

APPENDIX A

Petitioner's Trade-Mark.



APPENDIX B.

Relevant parts of the Trade-Mark Act of 1946 (U.S.C. Title 15, Chap. 22) are as follows:

"Sec. 1: The owner of a trade-mark used in commerce may register his trade-mark under this Act on the principal register hereby established: * * *

"Sec. 2: No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—[specifying particular subjects of exclusion (a), (b), (c), and (d) not here pertinent].

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive * * * of them * * *.

["Section 2(f)"]

(f) Except as expressly excluded in paragraphs (a), (b), (c) and (d) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. * * *

"Sec. 23: Nature of mark. For the purposes of registration on the supplemental register, a mark may consist of any trade-mark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, or device or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

"Sec. 27: Registration of a mark on the supplemental register, or under the Act of March 19, 1920, shall not preclude registration by the registrant on the principal register established by this Act.

"Sec. 45: Trade-Mark. The term 'trade-mark' includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.

"Sec. 45: Mark: The term 'mark' includes any trade-mark, service mark, collective mark, or certification mark entitled to registration under this Act whether registered or not.

"Sec. 46(a): * * * All Acts and parts of Acts inconsistent herewith are hereby repealed effective one year from the enactment hereof, including the following Acts insofar as they are inconsistent herewith * * * the Act of February 20, 1905 * * * entitled 'An Act to authorize the registration of trade-marks used in commerce * * *."

APPENDIX C.

IN THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

CIVIL ACTION No. 3611-50

BURGESS BATTERY COMPANY

Plaintiff

vs.

JOHN A. MARZALL, Commissioner of Patents

Defendant

Plaintiff comes into Court for an adjudication authorizing the registration of a design consisting of vertical alternate light and dark stripes of indefinite size and extent, as a trade-mark for batteries on the principal register. On two prior occasions plaintiff endeavored to have registered this design. The registration was first refused by the Court of Customs and Patent Appeals in 1940.[1] Later in 1944 an attempt was made to register a shield surrounded by these same alternating light and dark stripes. This endeavor was likewise unsuccessful.[2]

In refusing registration in the second case, the Court of Customs and Patent Appeals, *inter alia*, stated:

> "To hold that appellant's mark is registrable without a disclaimer of the stripes would involve holding that the stripes possessed some trade-mark signifi-

[1] In re Burgess Battery Co., 112 F. (2d) 820 (1940).
[2] Application of Burgess Battery Co., 142 F. (2d) 466, 467 (1944).

cance contrary to our holding in the case of *In re Burgess Battery Company, supra.* As we adhere to our holding in said case, it follows that the decision appealed from should be affirmed."

Subsequent to the second *Burgess* case in the Court of Customs and Patent Appeals, Congress enacted the Trade-Mark Act of 1946 (15 U.S.C.A. §1051-1127). The 1946 Trade-Mark Act, also known as the Lanham Act, was enacted for the purpose of codifying, modernizing and [151] improving the trade-mark statutes of the United States. Among other things this Act liberalized the registration of certain trade-marks. Section 2(f) of the Lanham Act (15 U.S.C.A. §1052) permits the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce.

It is plaintiff's position that its design has acquired a secondary meaning so as to entitle it to registration under §2(f) of the Lanham Act, *supra.*[3]

Defendant asserts that plaintiff endeavors here to relitigate what the Court of Customs and Patent Appeals decided on two occasions adversely to it and that in any event the design is not a trade-mark, registrable under the Lanham Act.

I have reached the conclusion that the issue presented here is *res judicata* against plaintiff. On the two previous occasions plaintiff had its day in Court as to whether this stripes design is registrable as a trade-mark. Unless the Lanham Act changes the previous concept of a trade-mark, plaintiff is estopped from again litigating this issue. But the Lanham Act embraces the same idea of a

[3] Section 2(f), Lanham Act states as follows:
"Except as expressly excluded in subsections (a), (b), (c), and (d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce."

trade-mark which was expressed in the two *Burgess* cases, *supra*, and which was clearly fixed by the decisions and texts at the time the Act was passed.[4] Section 2(f) of the 1946 Act provides for the registration of a mark used by the applicant which has become distinctive of the appli- [152] cant's goods in commerce. The word "mark" is defined in §45 of the Act as follows:

> "The term 'mark' includes any trade-mark, service mark, collective mark, or certification mark entitled to registration under this chapter, whether registered or not." (15 U.S.C.A. §1127).

It is not claimed here that the present design is a service mark, collective mark or certification mark—therefore, unless it can be held to be a trade-mark within the meaning of the 1946 Act it cannot be registered on the principal register. Section 45 of the 1946 Trade-Mark Act defines a trade-mark as including "any word, name, symbol or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." This is almost identical with the conception of a trade-mark as it was considered in the *Burgess* cases.

In the first *Burgess* case the Court held as follows:

> "We think * * * that appellant's design is merely a colored label or dress of black and white alternating stripes, the office of which (design) is not to point out distinctly the origin or ownership of the articles to which the label is affixed."[5]

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[4] In re Burgess Battery Co., supra.
Application of Burgess Battery Co., supra.
McLean v. Fleming, 96 U. S. 245, 254.
Nims, Law of Unfair Competition, 4th Ed. (1947), p. 514.
Robert, New Trade-mark Manual, p. 4, 5.
Derenberg, The Lanham Trade-Mark Act, 38 T.M.R., 833.

[5] In re Burgess Battery Co., supra, p. 822.

If plaintiff's design "is not to point out distinctly the origin and ownership of the articles", as held in the *Burgess* case, then the same design does not identify the articles and distinguish them from others as required under the definition of a trade-mark in the 1946 Act. In each of the *Burgess* cases the Court clearly held that the stripes design was not and could not be a trade-mark. In the second case the Court stated that "stripes which are a mere dress of the goods can have no trade-mark significance." Thus, the design in the instant case was not a trade-mark in 1944 when the second case was decided. Because the 1946 Act did not give a new meaning to a trade-mark, the design cannot be considered a trade-mark now; hence the issue has been adjudicated by the pre-
[153] vious decisions.

However, assuming *arguendo*, that *res judicata* does not bar plaintiff in this case, it seems clear that the design in question is merely the dress of the goods and is inherently incapable of acquiring the status of a trade-mark under the 1946 Act.

Registration of a particular package or dress of goods on the principal register does not seem to be contemplated. This conclusion is fortified when one considers that §23, relating to the supplemental register contains a special definition of mark which includes "label, package, configuration of goods, etc." The omission of reference to labels or dress of goods in connection with the principal register and the inclusion thereof on the supplemental register would seem to indicate an intention to confine such matters to the supplemental register. The text writers since the 1946 Act have confirmed this conclusion.[6]

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[6] Derenberg, Second Year of Administration of the Lanham Act, 39 T.M.R., 657, 658.
Nims, op. cit., p. 331.
Amdur, Trade-Mark Law & Practice, p. 40.

While no Court decision has been cited or found on the effect of the 1946 Act to the point here in issue, the case of *Campbell Soup Co.* v. *Armour,* 175 F. (2d) 795, decided since the Act was passed is helpful. The Court there held "the mere division of label into two background colors, as in this case, is not, however, distinct or arbitrary." The District Court decision, 81 Fed. Supp. 114, which was affirmed on appeal pointed out that "red and white banding is mere tasty dress and cannot be monopolized."[7]

The Court concludes therefore that the prior holdings of the Court of Customs and Patent Appeals are *res* [154] *judicata* against the right of plaintiff to register its design and that, in any event, the stripes design in the instant case does not and inherently cannot have any trade-mark significance but is merely ornamental dress of the battery.

Findings of Fact and Conclusions of Law may be prepared consistent herewith.

LUTHER W. YOUNGDAHL
Judge

December 20, 1951

[7] See also Life Savers Corp. v. Curtis Candy Co., 182 F. (2d) 4 (CA 7, 1950).

APPENDIX D.

UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 11436

BURGESS BATTERY COMPANY, Appellant,

v.

ROBERT C. WATSON, Commissioner of Patents, Appellee

Appeal from the United States District Court
for the District of Columbia
Decided March 5, 1953

Mr. Howard H. Darbo, pro hac vice, by special leave of Court, with whom *Mr. Clarence M. Fisher* was on the brief, for appellant.

Mr. E. L. Reynolds, Solicitor, United States Patent Office, for appellee.

Before EDGERTON, CLARK, and WILBUR K. MILLER, Circuit Judges.

PER CURIAM: This is an appeal from a judgment dismissing the complaint in an action under Section 21 of the Trade-Mark Act of 1946, 15 U.S.C. § 1071, 60 Stat. 435, and Section 4915 of the Revised Statutes, 35 U.S.C. § 63, in which the appellant sought to have the court authorize the registration on the Principal Register, under

the provisions of Section 2 (f) of the Trade-Mark Act of 1946, 15 U.S.C. §1052, 60 Stat. 428, as a trade-mark for batteries, of a design consisting of alternate black and [fol. 149] white stripes of indefinite size and extent. The judgment is affirmed on the opinion of the District Court. *Burgess Battery Co.* v. *Marzall*, 101 F. Supp. 812.

Affirmed.

Wilbur K. Miller, Circuit Judge, dissents.

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In the Supreme Court of the United States

OCTOBER TERM, 1953

No. 157

BURGESS BATTERY COMPANY, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the United States District Court for the District of Columbia (R. 6-10) is reported at 101 F. Supp. 812. The *per curiam* opinion of the United States Court of Appeals for the District of Columbia Circuit (R. 148) is reported at 204 F. 2d 35.

JURISDICTION

The judgment of the Court of Appeals was entered on March 5, 1953 (R. 149). A petition for re-

hearing, filed on March 30, 1953 (R. 150) was denied on April 3, 1953 (R. 160).[1] The petition for a writ of certiorari was filed on June 29, 1953. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether two prior determinations of the United States Court of Customs and Patent Appeals, in proceedings filed in that court under R. S. 4911 (35 U.S.C. (1946 ed.) 59a), that petitioner's design was not a trade-mark are *res judicata* of petitioner's present suit brought under R. S. 4915 (35 U.S.C. (1946 ed.) 63) to compel registration of its alleged mark, in view of the fact that the Trade-Mark Act of 1946 did not change the definition of the term trade-mark.

2. Whether Section 2(f) of the Trade-Mark Act of 1946, which provides that nothing therein (with exceptions not relevant here) shall prevent the registration of a mark that has become distinctive of the applicant's goods in commerce, requires the registration of a design which, although distinctive of the applicant's goods to a substantial portion of the trade, is merely an ornamental dress for the goods and does not fall within the statutory definition of a trade-mark.

STATUTES INVOLVED

The pertinent provisions of the statutes involved are set forth in the Appendix, *infra*, pp. 12-16.

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[1] Although it does not appear in the record, the Court of Appeals, in an Order dated March 26, 1953, extended until March 30, 1953 the 15-day period within which to file a petition for rehearing (cf. General Rules of the United States Court of Appeals for the District of Columbia Circuit, Rule 26).

STATEMENT

This is an equitable proceeding brought pursuant to R.S. 4915 to compel the registration of a trade-mark (R. 1). Petitioner is a manufacturer of electric dry cell batteries, on which it prints its name against a background of black and white stripes. These stripes are prominently displayed upon all sides of the batteries. Their length, number, and apparently also their width, vary with the size and configuration of the several batteries. (R. 11, 14-15, 31-133.)

This is the third attempt petitioner has made to obtain the registration as a trade-mark of the striped background design as such. The first application, filed in 1938 (R. 18), was denied by the Patent Office. In a proceeding brought under R.S. 4911 [2] (35 U. S. C. (1946 ed.) 59a), *infra,* pp. 14-15, the Court of Customs and Patent Appeals held (see *In re Burgess Battery Co.,* 112 F. 2d 820) that the repetitious stripes covering the entire article did not constitute an emblem, symbol, figure, device, etc., but were merely an ornamental dress for petitioner's batteries and, hence, not a trade-mark. In 1940, petitioner sought the registration of a shield design surrounded by alternating dark and light stripes (R. 18). The Patent Office refused to register this mark unless petitioner disclaimed the striped features of the mark, on the ground that they were merely the dress of the goods, furnished only a background for the actual mark, and were in no other way a part of the design. Upon appeal, this

[2] R. S. 4911 was made applicable to trade-marks by Section 9 of the Trade-Mark Act of 1905. (33 Stat. 724, 727.)

decision of the Patent Office was affirmed by the Court of Customs and Patent Appeals in another R. S. 4911 proceeding on the ground that the stripes, not restricted in area, were the dress of the goods and could not become part of a trade-mark. See *Application of Burgess Battery Co.*, 142 F. 2d 466.

The present application was filed in 1947, and claimed that petitioner's design was entitled to registration under Section 2(f) of the Trade-Mark Act of 1946, *infra*, p. 12. After registration was denied by the Patent Office (R. 139-147), petitioner filed the instant equitable proceeding under R. S. 4915,[3] as amended (35 U. S. C. (1946 ed.) 63, *infra*, pp. 15-16), seeking to compel the registration of its claimed trade-mark, described as "a design consisting of a series of parallel alternating dark and light stripes of approximately equal width" (R. 1-2).[4] The District Court dismissed the complaint (R. 13), basing its decision primarily on the ground that since the definition of a trade-mark had not been changed by the Trade-Mark Act of 1946 (R. 7-9), the earlier holdings of the Court of Customs and Patent Appeals that petitioner's stripe design did not constitute a trade-mark, but merely an ornamental dress, were *res judicata* and conclusive of

[3] R. S. 4915 was repealed, effective January 1, 1953, by Section 5 of the Act of July 19, 1952, 66 Stat. 792, 815-816, which revised and enacted into positive law Title 35 of the United States Code. Existing rights and liabilities were not affected by the repeal. Its provisions were reenacted into law, with changes not material here, as §§ 145 and 146 of Title 35. 66 Stat. 803.

[4] The statement in the petition that the trade-mark consists of a panel of vertical alternating black and white stripes (Pet. 2) is far narrower than the broad description of the mark in the complaint.

the instant proceeding. The District Court, however, assuming that the earlier decisions might not be *res judicata,* found that in any event the striped design "is merely the dress of the goods and is inherently incapable of acquiring the status of a trade-mark under the 1946 Act." (R. 9)[5] The Court of Appeals affirmed the judgment on the opinion of the District Court (R. 148).

ARGUMENT

1. The concurring decisions of the District Court and the Court of Appeals, holding that the prior determinations of the Court of Customs and Patent Appeals to the effect that petitioner's design is not of the character which may be registered as a trademark is *res judicata* of the instant R. S. 4915 proceeding, followed the plain mandate of R. S. 4911, *infra,* pp. 14-15. At the times the proceedings were brought and considered by the Court of Customs and Patent Appeals, R. S. 4911[6] expressly provided that an applicant who proceeded in the Court of Customs and Patent Appeals waived his right to proceed in equity under R. S. 4915. In the circumstances, the courts below committed no error in holding that petitioner might not, after twice pursuing unsuccessfully his remedy in the Court of Customs and Patent Appeals, invoke still another remedy in an equity proceeding under R. S. 4915

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[5] See also Finding of Fact No. 5 (R. 12).

[6] R. S. 4911 was repealed, effective January 1, 1953, by the same act and with the same reservations as in the case of R. S. 4915. See footnote 3, *supra,* p. 4. Its provisions are now embodied, in substance, in § 141 of Title 35 of the United States Code.

in the face of the statutory command in R. S. 4911 that he had waived his right to do so.[7]

Petitioner's contention that the denials of its two earlier applications by the Court of Customs and Patent Appeals are no longer binding upon it, on the ground that the Trade-Mark Act of 1946 permits the registration of a trade-mark on a new and different basis (Pet. 5-6), is without merit. The contention overlooks completely the fact that the 1946 Act did not change the definition of the term trade-mark, since the definition of a trade-mark now embodied in Section 45 of the 1946 Act, *infra*, p. 14, is identical with its pre-1946 common law definition.[8] In fact, the first decision of the Court of Customs and Patent Appeals determining that petitioner's striped design did not constitute a trade-mark applied a test almost literally identical with the present statutory definition. See *In re Burgess Battery Co.*, 112 F. 2d 820, 821.

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[7] The remedy elected is conclusive of the issues raised and of those which might have been raised, and the applicant cannot escape this binding effect by the expedient of filing a second application. *Hemphill Co.* v. *Coe*, 121 F. 2d 897 (C.A.D.C.).

[8] The common law definition of the term "trade-mark" was first formulated in 1860 in Upton, *Trade-Marks*, p. 2: "A trade-mark is a name, symbol, figure, letter, form or device adopted by a manufacturer or merchant in order to designate the goods that the manufacturer or merchant sells and to distinguish them from those manufactured or sold by another * * *." This definition, adopted by the Supreme Court in *McLean* v. *Fleming*, 96 U.S. 245, 254, constitutes the basis of the definition of the term "trade-mark" in the 1946 Act. Cf. Nims, *Unfair Competition and Trade-Marks* (Fourth Ed., 1947) Vol. I, p. 186; see also Robert, *The New Trade-Mark Manual*, pp. 4-5; Derenberg, *The Lanham Trade-Mark Act of 1946*, 38 *The Trade-Mark Reporter* 831, (hereafter referred to as Derenberg) at 833.

2. The finding of fact made by the District Court and concurred in by the Court of Appeals that petitioner's stripe design constitutes merely ornamentation and cannot rise to the dignity of a trade-mark is supported by the related consideration that a design as simple and basic as colored stripes may not be monopolized as a trade-mark. Thus it has been held that colored stripes do not qualify as a trade-mark since they do not constitute a sufficiently complex combination of color with form elements. *James Heddon's Sons* v. *Millsite Steel & Wire Works,* 128 F. 2d 6, 9 (C.A.6), certiorari denied, 317 U.S. 674; see also *Life Savers Corp.* v. *Curtiss Candy Co.,* 182 F. 2d 4 (C.A. 7), involving a far more complex stripe design. Similarly, it was held in *Campbell Soup Co.* v. *Armour & Co.,* 175 F. 2d 795 (C.A. 3), certiorari denied, 338 U.S. 847, that the division of a label into two background colors is not sufficiently distinct and arbitrary to create a trade-mark. Apart from this, the trade-mark claimed by petitioner is alleged to consist "of a series of parallel alternating dark and light stripes of approximately equal width" (R. 1-2). There is no limitation to any particular color combination,[9] direction, or even width of the stripes.[10] This Court has held in *Leschen Rope Co.* v. *Broderick,* 201 U.S. 166, 171, that a trade-mark making such broad claims is invalid. And see also *Mishawaka R. & W. Mfg. Co.* v. *Panther-Panco Rubber Co.,* 153 F.

[9] Petitioner apparently claims every color combination which will photograph as dark and light (R. 22).

[10] Cf. R. 52.

2d 662, 665 (C.A. 1), certiorari denied, 329 U.S. 722.[11]

Moreover, a settled rule of this Court makes concurrent findings of two courts below final here in the absence of exceptional error. *Comstock* v. *Group of Investors,* 335 U. S. 211, 214; *Faulkner* v. *Gibbs,* 338 U. S. 267, 268; *General Pictures Co.* v. *Western Electric Co.,* 304 U. S. 175, 178. Petitioner has demonstrated no such error.

3. Basically, petitioner's argument is to the effect that under Section 2(f) (*infra,* p. 12) it can obtain registration upon the mere showing that the design has become distinctive of the applicant's goods in commerce and that it is immaterial whether or not the stripes constitute a trade-mark as defined in Section 45. This theory overlooks the statutory language which in terms predicates registration under Section 2 (par. 1) and subsection (f) (*infra,* p. 12) upon the existence of a trade-mark,[12] and misconceives the purpose Section 2(f) was intended to serve. The scope of Section 2 (f) is not to weaken the fundamental requirement that only a trade-mark or mark as defined in Section 45 may be entered in the principal register,[13] but to alleviate the

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[11] The denial of the trade-mark, of course, does not leave petitioner without remedy for unfair competition if a competitor should try to sell his batteries using the same striped design as petitioner. Cf. *Leschen Rope Co.* v. *Broderick,* 201 U.S. 166, 171; *Campbell Soup Co.* v. *Armour Co.,* 175 F. 2d 795, 799 (C.A. 3), certiorari denied, 338 U.S. 847.

[12] Derenberg, *ibid.,* at 839, 841; Robert, *The New Trade-Mark Manual* 49, 70.

[13] Registration in the principal register confers upon the owner "an unprecedented degree of security, dignity and ultimate incontestability." Derenberg, *ibid.,* at 833. Registration

rule embodied in Section 2(e) that a trade-mark, although complying with the definition of Section 45, must be denied registration if it is of a descriptive nature. Section 2(f) permits the registration of a descriptive trade-mark once it has become distinctive of applicant's goods in commerce.[14] The refusal to register petitioner's design, however, is not based on the defect that it is a descriptive trade-mark, but upon the fact that it does not constitute a trade-mark at all. This fatal defect, Section 2(f) is not designed to cure. Hence, the circumstance that the striped design has become distinctive of petitioner's goods in commerce is immaterial in view of the findings and binding adjudications to the effect that the design does not measure up to the definition of a trade-mark.

Petitioner infers (Pet. 7) that the decision of the court below is in conflict with the decision of the Court of Appeals for the Seventh Circuit in the case of *Barbasol Co.* v. *Jacobs,* 160 F. 2d 336, but that case presents no actual conflict. The Barbasol trade-mark which was upheld by the Seventh Circuit was not a mere striped design of indefinite size and extent. As the court pointed out (160 F. 2d at 339) its colored stripes form a border for a rectangular panel on a field in blue color, and this panel

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in the supplemental register (Section 23, *infra,* pp. 12-13), which confers privileges of a more limited scope (Section 26, *infra,* pp. 13-14), is also predicated upon the existence of a mark. The statutory definition of a mark entitled to registration under Section 23, however, is much broader than in Section 45.

[14] Derenberg, *ibid.*, at 839, 841.

constitutes an essential part of the entire design.[15] Furthermore, the recent decision of the Seventh Circuit in the case of *Life Savers Corp.* v. *Curtiss Co.*, 182 F. 2d 4, discloses that the Seventh Circuit is in complete agreement with the court below on the proposition that a mere striped design forming a background does not constitute a trade-mark.[16]

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[15] And see *Campbell Soup Co.* v. *Armour & Co.*, 175 F. 2d 795, 798-799, certiorari denied, 338 U. S. 847, wherein the Third Circuit, in discussing the *Barbasol* case, laid stress on the fact that the Barbasol trade-mark involved a package using several colors in a distinct and arbitrary design.

[16] The registration of the Chicopee Mills and Scotch Tape trade-marks by the Patent Office, also referred to by petitioner (Pet. 7), can scarcely be said to present conflicts with the decision of the court below which should be resolved by this Court. It will be noted that those patterns (R. 152, 154) are far more complex and distinct than the design now presented by petitioner, and it is not clear from the record whether those marks constitute a mere background, or whether they are given specific, arbitrary limitations. No doubt the Patent Office found that they constitute more than a mere ornamental dress, but the facts on which the findings were based do not appear in the record. In any event, the registration of those marks has no bearing on the instant case. Cf. *Lanolin Plus Cosmetics, Inc.* v. *Marzall*, 196 F. 2d 591, 592 (C.A.D.C.), certiorari denied, 344 U. S. 823.

Nor is there persuasion in petitioner's reference to the fact that it has obtained registration of its stripe design in Canada under a law "similar to the U. S. 1946 Act" (Pet. 3). Under Canadian law, the registration requirements are far more lenient, and, in turn, the statutory benefits of a registered mark are inferior to those granted by the Trade-Mark Act of 1946. Derenberg, *ibid.*, at 833.

CONCLUSION

The decision of the court below is correct and there is no conflict of decisions. There is no need for further review of this case. It is respectfully submitted that the petition for a writ of certiorari should be denied.

OSCAR H. DAVIS,
Acting Solicitor General.

WARREN E. BURGER,
Assistant Attorney General.

PAUL A. SWEENEY,
HERMAN MARCUSE,
Attorneys.

JULY, 1953.

APPENDIX

The Trade-Mark Act of 1946 (60 Stat. 427, 15 U. S.C. 1051-1127) provides in pertinent part:

SEC. 2. [60 Stat. 428, 15 U.S.C. 1052] No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

* * *

(e) consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when applied to the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 4 hereof, or (3) is primarily merely a surname.

(f) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration.

SEC. 23. [60 Stat. 435, 15 U.S.C. 1091] In addition to the principal register, the Commis-

sioner shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled "An Act to give effect to certain provisions of the convention for the protection of trade-marks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes", to be called the supplemental register. All marks capable of distinguishing applicant's goods or services and not registrable on the principal register herein provided, except those declared to be unregistrable under paragraphs (a), (b), (c), and (d) of section 2 of this Act, which have been in lawful use in commerce by the proprietor thereof, upon or in connection with any goods or services for the year preceding the filing of the application may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of section 1 so far as they are applicable.

* * *

For the purposes of registration on the supplemental register, a mark may consist of any trade-mark, symbol, label, package, configuration of goods, name, work, slogan, phrase, surname, geographical name, numeral, or device or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

* * *

SEC. 26. [60 Stat. 436, 15 U.S.C. 1094]

The provisions of this Act shall govern so far as applicable applications for registration and registrations on the supplemental register as well as those on the principal register, but applications for and registrations on the supplemental register shall not be subject to or receive the advantages of sections 2(e), 2(f), 7(b), 12(a), 13 to 18, inclusive, 22, 33, and 42 of this Act

* * *

SEC. 45. [60 Stat. 443, 15 U.S.C. 1127] In the construction of this Act, unless the contrary is plainly apparent from the context—

* * *

The term "trade-mark" includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.

* * *

The term "mark" includes any trade-mark, service mark, collective mark, or certification mark entitled to registration under this Act whether registered or not.

* * *

Section 4911 of the Revised Statutes of the United States, as amended, 44 Stat. 1336, 45 Stat. 1476, 53 Stat. 1212, 35 U.S.C. (1946 ed.) 59a, provided in pertinent part, as follows:

If any applicant is dissatisfied with the

> decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals: *Provided,* that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. * * *

Section 4915 of the Revised Statutes of the United States, as amended, 27 Stat. 436, 44 Stat. 1336, 45 Stat. 1476, 53 Stat. 1212, 35 U. S. C. (1946 ed.) 63, provided as follows:

> Whenever a patent or application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under

this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

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